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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

08350.0763-00000

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Application Number

10/054,952

Filed

January 25, 2002

First Named Inventor

James W. McCaherty

Art Unit

3629

Examiner

Michael J. Fisher

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒ attorney or agent of record.
Registration number 38,758

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

Elizabeth M. Burke
Typed or printed name

202-408-4488
Telephone number

May 29, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 form is submitted.

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PATENT
Customer No. 58,982
Attorney Docket No. 08350.0763-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
James W. McCaherty)	Group Art Unit: 3629
)	
Application No.: 10/054,952)	Examiner: Michael J. Fisher
)	
Filed: January 25, 2002)	
)	
For: METHOD AND SYSTEM FOR)	Confirmation No.: 6974
ANALYZING PAYLOAD)	
INFORMATION)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the rejections set forth in the final Office Action mailed on February 27, 2007. Applicant respectfully asserts that (1) the application has been at least twice rejected; (2) this request is being filed concurrently with a Notice of Appeal; (3) this request is being filed prior to an Appeal Brief; and (4) this request is five or less pages in length, all in accordance with the guidelines set forth in the Official Gazette Notice of July 12, 2005. Applicant requests the prompt review of the Examiner's rejections set forth in the final Office Action.

In the Final Office Action of February 27, 2007, the Examiner rejected claims 1-13, 16-29, and 31-41 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,605,081 to Helmly, Jr. et al. ("Helmly") and rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Helmly* in view of U.S. Patent No. 7,136,787 to Schlessinger et al. ("*Schlessinger*").

I. Rejection of claims 1-13, 16-29, and 31-41 under 35 U.S.C. § 103(a) as being unpatentable over *Helmly*

Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection of claims 1-13, 16-29, and 31-41 for at least the reason that *Helmly* fails to disclose or suggest each and every claimed element. For example, *Helmly* does not disclose or suggest a combination of steps including, *inter alia*, “calculating a modified target payload weight based on an analysis of previous payload weight” (emphasis added) as recited in independent claim 1.

The Office Action admits that *Helmly* does not “teach calculating a modified target payload weight based on the analysis” (Final Office action at p. 2). Nonetheless, the Office Action asserts that “[i]t would have been obvious to use the data for analyzing and modifying the payloads as *Helmly* teaches the system as being used to comply with government regulations ... and if a load is above legal limits the company would be in danger of legal action taken against it” (Final Office Action at pp. 2-3).

Helmly discloses a process “to automatically measure the gross weight, load, and length of trucks, such as at refineries, truck terminals, and depots” (Abstract). As part of its method, *Helmly* “compares the maximum allowable loaded weight with the actual scale weight and automatically actuates a printer to print a bill of lading for the truck, if the actual scale weight is less than the maximum legal weight” (column 2, lines 8-12). *Helmly* includes a “digital readout for displaying the measured weight and/or load of the truck and/or number of pounds that the truck is above or below the legal limit” (column 2, lines 16-20). Thus, while *Helmly* measures equipment weight, and indicates whether it complies with a “legal limit,” it does not calculate a modified target payload weight based on an analysis of previous payload weight, as recited in claim 1 (emphasis added).

Therefore, *Helmly* only discloses a “legal limit” for a piece of equipment. For example, in *Helmly*, “a legal weight determining module 160 compares the truck’s length, number of axles, and outside tires with preloaded data records and/or table based upon the Department of Transportation regulations and determines and selects the appropriate maximum allowable weight (legal limit) from the data table” (column 7, line 66 to column 8, line 4).

The “legal limit” in *Helmly* is the “target” payload, and should the actual weight of the load be over the target, the target does not change but remains the same. That is, *Helmly* does not calculate a “modified target payload,” as recited in claim 1 (emphasis added). The Office Action asserts that since “*Helmly* discloses ensuring that the trucks are not loaded over the legal limit, this would imply that there is a danger of the truck being overloaded even when it is loaded at what is expected to be the correct load and thus, as the system is used to ensure that trucks are not overloaded, it would be obvious to use the system to note that the trucks are overloaded and act accordingly” (Office Action at pp. 6-7). Applicant does not dispute that one might modify a payload found, according to *Helmly*, to be over limit. What Applicant disputes is that the target payload has changed. In each case, the target payload is the legal limit load, and thus the target payload is not modified.

Helmly teaches away from calculating a “modified target payload.” *Helmly* discloses determining whether equipment complies with a “legal limit,” which is predetermined by comparing “the truck’s length, number of axles, and outside tires” with the “records and/or tables based upon the Department of Transportation regulations” (column 7, line 65 to column 8, line 4). There is no teaching or suggestion in *Helmly* that the “legal limit” can be modified to provide a new target payload. Modifying the “legal limit” would be contrary to *Helmly*’s objective in determining compliance with a predetermined “legal limit.” Therefore, even if, as suggested by the Office Action (at p. 6), the system of *Helmly* were to be used to ensure that trucks are not overloaded, the “target payload” would still be the “legal limit,” which remains constant and is not a modified target.

For at least this reason, the rejection of claim 1 under 35 U.S.C. § 103(a) is not supportable and should be withdrawn. In addition, claims 2-13 and 15-16, which ultimately depend from independent claim 1, are allowable for at least the same reasons as cited above. Further, each of these dependent claims may recite unique combinations that are neither taught nor suggested by the prior art. Independent claims 17, 33, 40, and 41 although of different scope, recite similar features. Therefore, these claims are

also allowable for at least the same reasons as cited above. Dependent claims 18-29, 31-32, and 34-37 depend from one of these independent claims and are allowable for at least the same reasons.

Claim 38 recites "a method for reviewing a request for warranty service on a piece of equipment subject to a payload standard, the method comprising: receiving payload weight data associated with the piece of equipment; analyzing the payload weight data for compliance with the payload standard; and responding to the request for warranty service based on the analysis." The Office Action rejects claim 38 as obvious in view of *Helmly*. *Helmly* discloses a process to "measure the load and length of trucks, such as at refineries, truck terminals, and depots, to assure compliance with state highway laws and regulations" (column 1, lines 55-59). The Office Action states that "it would have been obvious to one of ordinary skill in the art to obtain payload compliance data to check for compliance as overloading a vehicle could void the warranty" (Final Office action at p. 5).

Helmly is silent with regard to requests for warranty service on a piece of equipment subject to a payload standard and Applicant is unclear how the Examiner's apparent modification would result in the claimed invention. There is simply no teaching in *Helmly* for at least "responding to the request for warranty service based on the analysis." Accordingly, for at least these reasons, Applicant respectfully requests withdrawal of the rejection of claim 38 under 35 U.S.C. § 103(a). Claim 39 depends from independent claim 38 and is therefore allowable for at least the same reasons.

II. Rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Helmly* in view of *Schlessinger*

Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection of dependent claim 15 as being unpatentable over *Helmly* in view of *Schlessinger*. *Schlessinger* fails to cure the deficiencies noted above with regard to *Helmly* and independent claim 1, from which claim 15 depends. Accordingly, claim 15 is allowable for at least the same reasons that independent claim 1 is allowable.

CONCLUSION


For the foregoing reasons, in addition to the reasons provided in the Reply to Office Action filed January 8, 2007, Applicant respectfully submits that the rejection of claims 1-13, 15-29, and 31-41 includes factual and legal deficiencies entitling Applicant to a pre-appeal brief review of the Final Office Action. As such, Applicant requests that the rejection be withdrawn and the claims allowed. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 29, 2007

By:


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